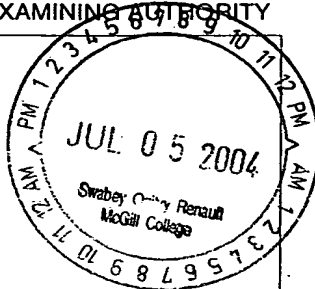


PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

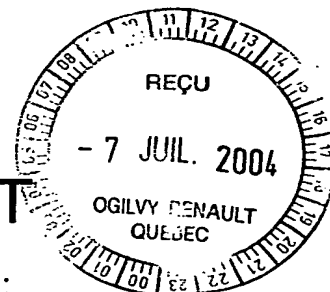
To: **MG**
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Montreal, Québec H3A 2Y3
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PCT

REPLY TO:
WRITTEN OPINION

(PCT Rule 66)



DUE ON AUG 28 2004

Applicant's or agent's file reference 6013-106PCT ✓		Date of mailing (day/month/year) 28.06.2004
International application No. PCT/CA 03/01080	International filing date (day/month/year) 16.07.2003	Priority date (day/month/year) 16.07.2002
International Patent Classification (IPC) or both national classification and IPC C07H15/04		
Applicant UNIVERSITE LAVAL et al.		


- This written opinion is the **second** drawn up by this International Preliminary Examining Authority.
- This opinion contains indications relating to the following items:
 - ☒ Basis of the opinion
 - ☐ Priority
 - ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - ☐ Lack of unity of invention
 - ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - ☐ Certain documents cited
 - ☐ Certain defects in the international application
 - ☐ Certain observations on the international application
- The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4. For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis. For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
- The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 16.11.2004

Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89.2399 - 4465	Authorized Officer Klein, D Formalities officer (incl. extension of time limits) Ambroa, J.R. Telephone No. +49 89 2399-8012
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I. Basis of the opinion

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, Pages

1, 5-21 as originally filed
2-4 received on 11.06.2004 with letter of 11.06.2004

Claims, Numbers

3-5 as originally filed
1, 2 received on 11.06.2004 with letter of 11.06.2004

Drawings, Sheets

1/8-8/8 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

WRITTEN OPINIONInternational application No. **PCT/CA 03/01080**

5. ☒ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

see separate sheet

6. Additional observations, if necessary:

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	Yes: 1-5 : No : ---
Inventive step (IS)	Claims	Yes: --- : No : 1-5
Industrial applicability (IA)	Claims	Yes: 1-5 : No : ---

2. Citations and explanations

see separate sheet


Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

- D1: LANG S ET AL: "ANTIMICROBIAL EFFECTS OF BIOSURFACTANTS"
FETT WISSENSCHAFT TECHNOLOGIE- FAT SCIENCE TECHNOLOGY,
CONRADIN INDUSTRIEVERLAG. LEINFELDEN ECHTERDINGEN, DE, vol.
91, no. 9, 1989, pages 363-366, XP002165892 ISSN: 0931-5985
- D2: PATENT ABSTRACTS OF JAPAN vol. 2000, no. 09, 13 October 2000
(2000-10-13) & JP 2000 169495 A (TAKEDA CHEM IND LTD), 20 June
2000 (2000-06-20)

1) Amendments (Rule 70.2(c) PCT) :



The amendments filed with letter of 11.06.2004 do not comply with the requirements of Rule 70.2(c) PCT for they are considered to go beyond the disclosure as originally filed. The Examiner understands that the definition of L (as well as the side chain bearing this L group) could have been mistyped, nevertheless, as no passage in the description discloses or **unambiguously** suggests these modifications, they cannot be taken as the basis of new allowable claims. Furthermore, even if the examiner accepted this modification, there would be then a problem concerning the length of the side chain bearing the L group as the second possible L group remains a propyl moiety.

Therefore the amended claims 1-2, and by extension former claims 3-5 dependant on new claim 1, as well as new pages 2-4 are not considered allowable.

2) In order to accelerate the proceedings, the following comments can be made :

- a) The applicant says, in his response, that the substituent in D1 "corresponding to G is always H, while in the compounds of the present invention, G has now been restricted to an acetyl.". As presently claimed (and disclosed in the application), this is **not** the case, G can (still) be H or acetyl.
- b) Furthermore, in order to show that the combination of D1 and D2 is improper (2nd paragraph of 2nd page of his answer), the applicant says that when n=1 in D2 the

**WRITTEN OPINION
SEPARATE SHEET**

International application No. PCT/CA 03/01080

length of the side chain is 18 carbon atoms. The examiner agrees with that. Nevertheless, D1 shows compounds bearing a C₁₆ side chain and D2 discloses the terminal part of the claimed compounds.

Taken from another angle D2, when n=0 shows a C₁₆ side chains which does not bear an hydroxy in position 2 (but has the same terminal part as claimed in original claim 1) while D1 discloses a C₁₆ side chain having an hydroxy in position 2.

Therefore, the examiner does not agree when the applicant says that the combination of D1/D2 is improper. On the contrary, the examiner considers the combination of D1/D2 as most relevant.

In fact the claimed compounds are so closely related to the ones disclosed in the prior art that, in order to acknowledge inventive step, the applicant is invited to demonstrate by evidence any advantage of the claimed compounds vis-à-vis the cited prior art.